

### **REMARKS**

This paper responds to the Office Action mailed on January 10, 2007.

Claims 1, 5, 6, 8, 14, 16 and 17 are amended, no claim is canceled, and no claims are added; as a result, claims 1-21 are now pending in this application.

#### **§112 Rejection of the Claims**

Claim 14 was rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. Although Applicants do not agree with the Examiner's rejection of claim 14, in order to provide additional clarity, claim 14 is amended to recite, in pertinent part, that: "...the first coating includes *a nitride of tungsten*". (Emphasis added). The Examiner is directed to, *inter-alia*, page 9, line 28, bridging to page 10, line 1 for this disclosure. Applicants submit that the claim 14 is allowable, and respectfully request that the rejection under 35 U.S.C. § 112, first paragraph be removed.

In addition, claims 6 and 16 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. With regard first to claim 6, Applicants again do not agree with the Examiner's position, but nevertheless have amended claim 6 in order to add further clarity to the claim. Accordingly, claim 6 now recites, in pertinent part, "...*further comprising spreading a printable material onto the top surface of the stencil*...". (Emphasis added). Applicants submit that claim 6 is allowable, and respectfully request that the rejection under 35 U.S.C. § 112, second paragraph be removed.

Turning now to claim 16, the Examiner has indicated that claim 16 is "confusing", since it is unclear whether Applicants are claiming the second coating as the means for controlling the running property of the adhesive. Applicants disagree with the Examiner's rejection. The Examiner is reminded that "...unless the means plus function language is unclear, a claim limitation written in a means plus function language *meets the definiteness requirement of 35 U.S.C. § 112, second paragraph, so long as it meets the written description requirement of 35 U.S.C. § 112, second paragraph*...". (Emphasis added). *In re Noll*, 545 F.2d 141, 149; 191 USPQ2d 721, 727 (CCPA 1976). Applicants maintain that the claim language does express the

required clarity, and that the Examiner's rejection under 35 U.S.C. §112, second paragraph, is misplaced.

Nevertheless, in order to add additional clarity, Applicants have amended claim 16 to recite, in pertinent part: "...wherein *at least one of the first coating and the second coating* includes means for controlling a running property of an adhesive." (Emphasis added). Justification for this amendment may be found in the present application at page 10, lines 5-15, which states, in pertinent part, that: "...a stencil having a pattern with a plating or coating *on at least a top or side surfaces* of the pattern to promote spreading of adhesive onto the die, *but without a coating on the bottom surface pattern* to retard running of the adhesive onto the bottom surface, is also within the scope of the invention." (Emphasis added).

Applicants therefore respectfully submit that claim 16 is not a "substantial duplicate of present claim 11 within the meaning of 37 CFR §1.75. Applicants also respectfully submit that claim 16 is allowable, and that the rejection under 35 U.S.C. §112, second paragraph, should be removed.

Claims 1, 5, 8 and 17 are amended to correct a clerical error. In particular, the foregoing claims are amended to recite "stencilling", and to delete the recitation of "stenciling". It is understood that claims 1, 5, 8 and 17 are amended solely to correct this typographical error.

#### Allowable Subject Matter

Claims 1-5, 8-13, 15 and 17-21 were allowed. The Examiner is thanked for his careful review of the present application and for his indication of allowable subject matter.

#### Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference.

Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

21 Feb '07

By

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 21 day of February 2007.

Kate Gannon

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Name

Signature